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09/716,918	11/20/2000	Jay S. Walker	98-010-C1	9324
22927 7590 04/06/2011 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
LEIVA, FRANK M				
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3717				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/716,918

**Applicant(s)**

WALKER ET AL.

**Examiner**

FRANK M. LEIVA

**Art Unit**

3717

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/C2.06)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. In view of the final decision made by the Board of Patent Appeals and Interferences on 05 January 2011, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.
2. This action will act upon the last amendment to the claims filed 13 April 2007 canceling claims 1-49 and pending claims 50-77 remaining.
3. A Technology Center (TC) Director has approved of reopening prosecution by signing below:

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:  

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Based upon consideration of all the relevant factors with respect to the claim as a whole, Claim(s) 50-73 are held to claim an abstract idea, and are rejected as ineligible subject matter under 35 U.S.C. 101.
6. The rationale for this finding is explained below, which is a result of careful consideration of the listed factors when analyzing the claim(s) as a whole to evaluate whether a method claim is directed to an abstract idea. These factors are not intended to be exclusive or exhaustive.

#### **Factors weighing toward eligibility are:**

Recitation of a machine or transformation: In particular, machine or transformation meaningfully limits the execution of the steps, a machine implements the claimed steps, the article being transformed is particular, an object or substance, the article undergoes a change in state or thing (objectively different function or use);

Practically applying a law of nature to meaningfully limit the execution of the steps; or

The claim is more than a mere statement of a concept: It describes a particular solution of the problem to be solved; implements a concept in a tangible way, performance of steps are observable and verifiable.

**Factors weighing against eligibility are:**

No recitation or insufficient recitation of a machine or transformation:

+ Insufficient involvement of the machine or transformation, merely nominally, insignificantly, or intangibly related to the performance of the steps, (e.g., data gathering, or merely recites a field in which the method is intended to be applied).

+ Machine is generically recited such that it covers any machine capable of performing the claimed step(s) or merely an object on which the method operates.

+ Transformation involves only a change in position or location of the article.

Improperly applying a law of nature that would monopolize a natural force or patent a scientific fact (e.g., by claiming every mode of producing an effect of that law of nature); or applied in a merely subjective determination or merely nominally, insignificantly, or tangentially related to the performance of the steps; or

The claim is a mere statement of a general concept: Use of the concept, as expressed in the method, would effectively grant a monopoly over the concept; or both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus; or states only a problem to be solved; or general concept is disembodied; or mechanism by which the step(s) are implemented is subjective or imperceptible.

+ Examples of general concepts: Basic economic practices or theories, basic legal theories, mathematical concepts, mental activity, interpersonal relations or relationships, teaching concepts, human behavior, and instructing how business should be conducted.

**7. Claim(s) 50, 71 and 72** are ineligible subject matter because the claimed limitations of counting occurrences of at least one tracked symbol, providing a bonus payout, and rules regarding the expiration of the appearances of the symbols include no

recitation or insufficient recitation of a machine or transformation, are not directed to a proper application of a law of nature, or are just a mere statement of a general concept.

**8.** Dependent **Claims 51-70 and 73**, when analyzed as a whole, are held to be ineligible subject matter and are rejected under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish that the claim is not directed to an abstract idea as detailed below:

**9.** Additional limitations of an outcome generated by a gaming device recited in dependent claims 65, 66 and 69 are no more than a field of use or merely involve insignificant extra-solution activity or intangibly related to the performance of the steps. The gaming device simply performs its normal operation and the steps of counting are performed by just observing the gaming device in operation.

#### ***Claim Rejections - 35 USC § 103***

**10.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**11. Claims 50-54, 56-58, 60-62 and 65-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5,833,537).**

**12.** Regarding the art of reference; Barrie discloses multiple embodiments based on different base games and different features based on the same tracking of persistent symbols.

**13. Regarding claim 50;** Barrie discloses a method comprising generating an outcome represented by a plurality of symbols, (selection of 20 numbers), (col. 6:27-32) example of a keno game; counting occurrences of at least one tracked symbol, thereby

determining a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition, (col. 5:25-52), wherein the game is keno and instead of a spin it is a number draw; determining whether the number is at least a minimum number, (col. 6:34-38); providing, if the number is at least a minimum number, a bonus payout based on the number of occurrences of the at least one tracked symbol, (col. 6:34-38), in the keno embodiment of Barrie a minimum number of symbol positions (number draws) on the simulated keno card have been filled that is also applicable to figure 1 and figure 6 simulated video slot wheels that count the occurrences of the symbols and according to (col. 2:66- col. 3:2) would also be applicable to a simulated keno card; wherein the expiration condition defines at least one of a number of plays, from a play in which an occurrence occurs, after which the occurrence expires, (col. 5:40-52); a period of time, from a time at which an occurrence occurs, after which the occurrence expires, (col. 5:40-52); and further wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time, (col. 5:40-52).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the embodiment of figures 1 and 3, and figure 5 as described in col. 6 lines 27-38 in a manner of a keno embodiment as disclosed in col. 2 line 66 through col. 3 line 2, with the features as described in col. 5 lines 40-52, as suggested by Barrie's language in col. 5 line 44, "Other types of delete events can be used", col. 9 line 29, "a number of variations and modifications of the present invention can also be used", and col. 9 line 44, "Although the invention has been defined by way of a preferred embodiment of a video slot machine and certain variations and modifications, other variations and modifications can also be used". Since Barrie shows the embodiment of figure 1 and 3 to be also a keno game by substituting a spin for a number draw (col. 5 line 28), and Figure 5 depicting an electronic keno game, Barrie has shown that the features listed in his invention and a variety of variations and modifications of the invention to have been obvious to implement these features into a single embodiment and working together. One would have been motivated to provide

player with increased level of enjoyment and tendency to increase time of play to benefit the gaming establishment.

**14. Regarding claim 51;** Barrie discloses wherein counting occurrences of at least one tracked symbol includes incrementing a count value by an integer value, (col. 5:25-35).

**15. Regarding claim 52;** Barrie discloses wherein the expiration condition includes a number of plays after which an occurrence of the at least one tracked symbol expires, and wherein the method further includes determining an expiration of an occurrence of the at least one tracked symbol based on the expiration condition, (col. 2:23-33).

**16. Regarding claim 53;** Barrie discloses wherein the expiration condition includes a time after which an occurrence of the at least one tracked symbol expires, and wherein the method further includes determining an expiration of an occurrence of the at least one tracked symbol based on the expiration condition, (col. 2:23-33).

**17. Regarding claim 54;** Barrie discloses counting of tracked symbols for any payout amount (Figure 3). As so claimed the tracking of predetermined symbols occurs for any payout amount less then the predetermined amount above the maximum payout amount. In this light the applicant's "less than a predefined amount" is equated to any amount predefined above the maximum payout amount.

**18. Regarding claim 56;** Barrie discloses remote game administration (col. 4:42-4:60) including a server system (central computer) for game state operation and tracking. Barrie utilizes remote hardware game management including all related processing functionality this is understood to encompass the storage and execution of software as well as performing as a server of the game to the remotely located player.

**19. Regarding claims 57 and 58;** Barrie discloses the claimed determination of a bonus payout based on the number of plays and/or the a duration of time, is considered taught above by Barrie through the requirement of completing a grid prior to the expiration of at least one symbol presently held in the grid, (col. 5:40-52).

**20. Regarding claim 60;** Barrie discloses awarding payouts (Figure 3 (326)) in response to the count and a placed wager (312), where the count excludes expired symbols (322); (col. 5:60-65).

**21. Regarding claim 61;** Barrie discloses the use of offsetting Symbols (black ball) for decrementing the count value with each occurrence of the black ball on a persistent symbol location (col. 4:8-22).

**22. Regarding claim 62;** Barrie discloses the use of multiplier symbols wherein the bonus payout includes the determination of a multiplier to be applied to the payout (Figure 4).

**23. Regarding claim 65;** Barrie discloses generating an outcome is performed by a gaming device, (col. 2:23-33).

**24. Regarding claim 66;** Barrie discloses wherein the gaming device includes a reel slot machine and the symbols include reel symbols, (col. 5:26-30, and fig. 1), wherein the embodiment can be of a video slot machine.

**25. Regarding claim 67;** Barrie discloses wherein the reel slot machine includes a symbol display window and a payout line visible within the symbol display window; and wherein counting occurrences of at least one tracked symbol includes selecting at least one tracked symbol from among all symbols displayed in the symbol display window, figs. 1 and 1A) Red Balls.



**26. Regarding claim 68;** Barrie discloses wherein counting occurrences of at least one tracked symbol includes selecting the at least one tracked symbol from among symbols on a specified reel of the reel slot machine, (fig. 1A) each occurrence tracked by location on specific reel.

**27. Regarding claim 69;** Barrie discloses the use of a video poker embodiment including the use of playing cards (col. 3:2-5).

**28. Regarding claim 70;** Barrie discloses providing a payout based on the results of a first game, the counting of predetermined symbols, and embodiments which further include the use of card games (col. 3:2-5) as taught above however Barrie is silent regarding the use of face value cards for the purpose tracked symbols. As no stated problem is solved or unexpected result obtained in the utilization of card face values in the place of the symbols of Barrie this feature is deemed to be a matter of design choice. It would have been obvious to one of ordinary skill in the art at the time of invention to modify using card face values in the place of the symbols of Barrie in order to allow the persistent symbol feature depiction in order to associate the persistent symbols to a desired game theme.

**29. Regarding claim 71;** Barrie discloses a method comprising identifying at least one tracked symbol, (col. 2:7-22); associating an expiration condition with each occurrence of the at least one tracked symbol wherein each occurrence of the at least one tracked symbol expires after its associated expiration condition has been satisfied, such that a first occurrence of the at least one tracked symbol may expire at a first time while a second occurrence of the at least one tracked symbol may expire at a second time that is different from the first time, (col. 4:8-22); determining a number of qualifying occurrences of the at least one tracked symbol, (col. 6:34-38); determining whether the number is at least a minimum number, (col. 6:34-38); and providing, if the number is at least the minimum number, a bonus payout based upon the number of qualifying occurrences of the at least one tracked symbol, wherein the number equals the number

of occurrences of the tracked symbol during play less the number of expired tracked symbols, (col. 6:34-38).

It would have been obvious to one of ordinary skill in the art at the time of applicants invention to modify the embodiment of figures 1 and 3, and figure 5 in a manner viewing a keno embodiment as discloses in column 2 line 66 through column 3 line 2, with the features as described above, as suggested by Barrie's language in col. 5 line 44, "Other types of delete events can be used" and col. 9 line 29, "a number of variations and modifications of the present invention can also be used", or col. 9 line 44, "Although the invention has been defined by way of a preferred embodiment of a video slot machine and certain variations and modifications, other variations and modifications can also be used". Since Barrie shows the embodiment of figure 1 and 3 to be also a keno game by substituting a spin for a number draw (col. 5 line 28), and Figure 5 depicting an electronic keno game, Barrie has shown the features listed in his invention and a variety of variations and modifications of the invention to have been obvious to implement these features into a single embodiment and working together. One would have been motivated to provide player with increased entertainment and tendency to play multiple rounds of the game.

**30. Regarding claim 72;** Barrie discloses a method comprising identifying at least one tracked symbol having an associated expiration condition wherein an occurrence of the at least one tracked symbol expires upon the associated expiration condition becoming satisfied, (col. 4:8-22); identifying a bonus value, (col. 6:34-38); determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence, (col. 5:25-35 and col. 5:66-col. 6:23); and providing a bonus payout when the count value exceeds the bonus value, (col. 6:34-38).

It would have been obvious to one of ordinary skill in the art at the time of applicants invention to modify the embodiment of figures 1 and 3, and figure 5 in a

manner viewing a keno embodiment as discloses in column 2 line 66 through column 3 line 2, with features has described above, as suggested by Barrie's language in col. 5 line 44, "Other types of delete events can be used" and col. 9 line 29, "a number of variations and modifications of the present invention can also be used", or col. 9 line 44, "Although the invention has been defined by way of a preferred embodiment of a video slot machine and certain variations and modifications, other variations and modifications can also be used". Since Barrie shows the embodiment of figure 1 and 3 to be also a keno game by substituting a spin for a number draw (col. 5 line 28), and Figure 5 depicting an electronic keno game, Barrie has given motivation for the features listed in his invention and a variety of variations and modifications of the invention to have been obvious to implement these features into a single embodiment and working together. One would have been motivated to provide player with increased entertainment and tendency to play multiple rounds of the game.

**31. Regarding claim 73;** Barrie discloses wherein determining a count value further includes initializing the count value upon initiation of a session of play by a player, (col. 5:25-35); and terminating the determining of the count value upon termination of the session of play by the player, (col. 5:44-52).

**32. Regarding claim 74;** Barrie discloses a gaming device comprising a processor; a memory coupled to the processor storing a program to control the operation of the processor, (fig. 2); the processor operative with the program to generate an outcome represented by a plurality of symbols, (col. 2:7-22 and col. 2:38-41); count occurrences of at least one tracked symbol, thereby determining a number of occurrences of the at least one tracked symbol, (col. 5:25-35); and determine whether the number is at least a minimum number, (col. 6:34-38); and provide, if the number is at least a minimum number, a bonus payout based on a number of occurrences of the at least one tracked symbol counted in accordance with an expiration condition, (col. 6:34-38), wherein the expiration condition defines at least one of (i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires, (col. 2:22-32), and (ii) a period

of time, from a time at which an occurrence occurs, after which the occurrence expires, and further wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time, (col. 5:44-52).

It would have been obvious to one of ordinary skill in the art at the time of applicants invention to modify the embodiment of figures 1 and 3, and figure 5 in a manner viewing a keno embodiment as discloses in column 2 line 66 through column 3 line 2, with the features as described above, as suggested by Barrie's language in col. 5 line 44, "Other types of delete events can be used" and col. 9 line 29, "a number of variations and modifications of the present invention can also be used", or col. 9 line 44, "Although the invention has been defined by way of a preferred embodiment of a video slot machine and certain variations and modifications, other variations and modifications can also be used". Since Barrie shows the embodiment of figure 1 and 3 to be also a keno game by substituting a spin for a number draw (col. 5 line 28), and Figure 5 depicting an electronic keno game, Barrie has given motivation for the features listed in his invention and a variety of variations and modifications of the invention to have been obvious to implement these features into a single embodiment and working together. One would have been motivated to provide player with increased level of enjoyment and tendency to increase time of play to benefit the gaming establishment.

**33. Regarding claim 75;** Barrie discloses wherein the processor counts occurrences of the at least one tracked symbol by incrementing a count value by an integer value, (col. 5:25-35).

**34. Regarding claim 76;** Barrie discloses wherein the expiration condition represents a number of plays after which an occurrence of the at least one tracked symbol expires and the processor is further operative with the program to determine an expiration of an occurrence of the at least one tracked symbol based on the expiration condition, (col. 5:44-52).

**35. Regarding claim 77;** Barrie discloses wherein the expiration condition represents a time after which an occurrence of the at least one tracked symbol expires and the processor is further operative with the program to determine an expiration of an occurrence of the at least one tracked symbol based on the expiration condition, (col. 5:44-52).

**36. Claims 55, 59, and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie (US 5,833,537) in view of Weiss (US 6,165,071).**

**37. Regarding claims 55, 59 and 63;** Barrie discloses the inclusion of a "player card" however is silent regarding the memory, tracking, and player compensation abilities capabilities of said player card (col. 5:47-49). In a related application however Weiss discloses the use of a player card system (Weiss col. 2:24-27) for allowing a player to complete a game a in a series of gaming sessions including the storage of the player's current game state (Weiss col. 3: 11 -22), player tracking functions (Weiss col. 1:39-67), and the determination of player rewards for continued play (Weiss col. 1:39-56). It would have been obvious to one of ordinary skill in the art at the time of invention to modify Barrie by incorporating the continued play incentive program including the portions described above into the system/method of Barrie in order to encourage continued game play among players.

**38. Regarding claim 64;** Barrie discloses associating a zero payout for those symbols which have expired (col. 8:1-10 and Abstract) and as such encompasses the claimed "determining a payout for expired occurrences of the at least one tracked symbol" .

1) "A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." KSR, 550 U.S. , 82 USPQ2d at 1397. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* Office personnel may also take into account, "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.*, 82 USPQ2d at 1396. In addition to the factors above, Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art. The Federal Circuit has stated that examiners and administrative patent judges on the Board are "persons of scientific competence in the fields in which they work" and that their findings are "informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art." *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003).

2) The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571) 272-2460. The examiner can normally be reached on M-F 11:00 am - 4:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on (571) 272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. M. L. /  
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